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Paper No. 7

Foley & Lardner
402 W. Broadway, 23rd Floor
San Diego, Ca 92101

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APR 13 2001

In re Application of
Dershem et al.
Application No. 09/580,026
Filed: May 26, 2000
For: Thermosetting Resin Compositions
Containing Maleimide and/or Vinyl
Compounds

: **OFFICE OF PETITIONS**
: **A/C PATENTS**
: **DECISION REFUSING STATUS**
: **UNDER 37 CFR 1.47(a)**
:
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This is in response to the petition under 37 CFR 1.47(a), filed March 7, 2001.¹

The petition is dismissed.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition under 1.47(a)," and should only address the deficiencies noted below. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a). The reply to this decision may include an oath or declaration executed by the nonsigning inventors in compliance with 37 CFR 1.63.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the nonsigning inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; (4) a statement of the last known address of the nonsigning inventor. Applicant lacks item (1) set forth above.

¹ In view of the statement in the petition to charge any additional fees required to Deposit Account No. 50-0872, a fee of \$500 (\$1890-\$1390=\$500) for a five month extension of time will be charged to petitioner's deposit account in order to render the filing of the petition timely.

As to item (1), Rule 47 applicant has failed to provide evidence of diligent efforts to reach the nonsigning inventors and has failed to adequately show or provide proof that the nonsigning inventors have refused to sign the declaration after having been presented with the application papers (specification, claims, and drawings and oath or declaration). The petition states that a copy of the application papers was forwarded to both of the nonsigning inventors for their signatures and petitioner has submitted as evidence copies of the "Federal Express" Track Shipment records.

While the "Signed For By" section listed on the Federal Express tracking records, one record with the number "12728909" listed and the other record with the name "W. Desall" listed, indicates that the application papers could have been delivered and accepted, the evidence provided is not sufficient to establish that the nonsigning inventors have refused to sign the declaration and is not sufficient to show that the nonsigning inventors have been presented with a complete copy of the application papers. The "Federal Express" Track Shipment records do not indicate that the application papers were delivered to the last known address and/or have been received by either of the nonsigning inventors. The tracking records do not contain a signature which would indicate that the application papers were delivered to and accepted by the nonsigning inventors. Petitioner must provide additional evidence that would indicate that the complete application papers were forwarded to the last known address of each of the nonsigning inventors and copies of documentary evidence, such as, cover letter of instructions, certified mail return receipt listing the last known address of each of the nonsigning inventors, telegram etc., must be submitted to support a conclusion that the nonsigning inventors have refused to join in the application after having been presented with the complete application papers. Additionally, while the petition states that "more than sufficient attempts" were made to obtain the signatures of the nonsigning inventors, petitioner has not stated what these attempts were nor has petitioner submitted any documentary evidence in support of this statement. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events and should include documentary evidence in support thereof.

Where there is an express or oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

In order to expedite consideration of the petition under 37 CFR 1.47(a), petitioner may wish to consider submitting the renewed petition by

facsimile transmission to the telephone number indicated below and to the attention of Latrice Bond.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Office of Petitions
Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries related to this decision should be directed to Latrice Bond at (703) 308-6911.


Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy